UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
WEST, JEFFREY R

ART UNIT	PAPER NUMBER
2857	

DATE MAILED: 06/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 May 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may <u>only</u> be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

    (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

    (b) ☐ they raise the issue of new matter (see Note below);

    (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

    (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.
        NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☐ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

    The status of the claim(s) is (or will be) as follows:

    Claim(s) allowed: _____.

    Claim(s) objected to: _____.

    Claim(s) rejected: _____.

    Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____.

MARC S. HOFF
SUPERVISORY PATENT EXAMINER
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Applicant argues that "[s]nyder does not teach the use of a user-defined function. Rather Snyder allows for the user to select between a number of functions previously defined [functions] (i.e. functions defined by the original programmer). There is no teaching in Snyder that any of these functions is a user-defined function. The user may select which function to use, but no mechanism is provided for the user to define the function itself. Thus, the user is restricted to the previously defined functions listed in the menu. No facility is provided for a new, user-defined function to be provided. Snyder allows the user to modify the data input to a function. This may alter the operation of the function but this does not define the function. In contrast the present invention allows the user to define the function by providing a software module. The applicant asserts that a user-selected function is not equivalent to a user-defined function."

First, the Examiner asserts that "defined" is a broad term that can be broadly mean "to specify distinctly" or "to give form or meaning to" and therefore is met by "user-selected" or a process to "modify the data input in order to alter the operation of".

Secondly, Applicant admits that Snyder teaches modifying the input data to a function in order to alter the operation of the function, and therefore to alter the measurement process, while the instant specification indicates that "[i]n operation, when a variation point is reached, control passes to a user-defined process or subsystem. The user-defined subsystem performs one or more actions, including modification of measurement data, control of a device being tested and variation of numerical and control parameters defining the measurement process" (abstract).

Thirdly, in column 26, lines 33-67, Snyder discloses providing a menu function that the user defines though selection of a particular choice (i.e. "Menu Choice Selection: When the user selects a choice on the frmMenu form, the selection can be logged to the central logger with USER_EVENT severity and cls-MenuInt's Sub SelectChoice(choice As Integer) can be called. The routine can retrieve the clsMenu object (at index "choice") from the MenuChoice collection. Based on the value of its action_type attribute one of the following can occur:") and that this user-defined function is associated with a variation function (i.e. "Action type 'PROCEDURE': Indicates control can be transferred to a test executive internal procedure. The cls-Menu object's 'action' attribute can contain a keyword which can be used to identify the procedure to be called"). Therefore Snyder discloses a function that is defined by a user in a particular manner to cause a user-desired variation in the process and meets the limitation as claimed.

Further still, Snyder also describes the menu function as being accessed by the operator "to select a sequence of tests" and "for a given test, the computer determines the test's name, test variable, independent variables, and ranges for those independent variables. This determination can be accomplished by first determining the test's name, and then querying a specification table that relates the 'recipe' for the test, i.e., the test variable, independent variables, and independent variable ranges, to the test name. Thus, the test executive can retrieve the recipe for the given test in the batch" (column 5, lines 8-22). Therefore, it can be seen that when the process begins, a particular test is not defined. Upon reaching a variation point, the user is presented with a menu function in which a selection by the user causes the test executive to define a particular test.

Applicant then describes the specification and indicates that "[i]n contrast, the Snyder reference only allows the user to select between pre-defined test functions and to alter the parameters of pre-defined functions. In the Snyder system, the user does not provide the code module, as called for in claim 1, rather the user selects between pre-existing code modules. Further, in Snyder the code contains functions pre-determined by the designer of the program. It is not clear how this code could contain user-defined functions, since the user is normally unknown at the time the program is written."

As noted above, the menu function of Snyder is defined by the user to cause a user-desired variation. Further, it has been held that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claim 1 does not contain a limitation requiring the user to provide a code module.

Applicant then argues that "Snyder does not teach 'associating the user-defined function with the variation function'. In the specification on page 14, lines 19-25, various methods for associating the user-defined function with the variation function. Placing the code module in a predetermined directory or registering the function with an operating system are steps preformed by the user once the user has generated the software module. This step is not taught by Snyder. The selection of a function from a menu list typically results in a parameter being returned to the main program. This parameter is then used to control program flow. The pre-defined functions are presumably already associated and do not need to be associated by the user."

The Examiner again notes that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. Therefore, the details from the specification describing placing a code module in a predetermined directory or registering the function with an operating system are not read into the claims

Secondly, as noted above, in column 26, lines 33-67, Snyder discloses providing a menu function that the user defines though selection of a particular choice and that this user-defined function is associated with a variation function.

Applicant argues that "[c]laim 14 calls for the variation to comprise modification of data. This modification of data is achieved by providing a software module that includes a user-defined function. In contrast, Snyder modifies data by providing parameters (from a database) to a pre-defined function." This argument, however, is considered moot in light of the explanation provided above.

Applicant argues that "Snyder does not describe the user of 'variation points' where a user-defined variation function is invoked. Applicant submits that the point at which a menu subroutine is called is not equivalent, since the menu subroutine is not a user-defined variation function. Further, on return from the menu subroutine, control is passed to a previously defined routine selected by the user, rather than to a user-defined routine as called for in the present invention."

The Examiner maintains that the invention of Snyder discloses a testing program that reaches a variation point, at which time a process modification software module is provided including a user defined function for causing the variation and associating the user-defined function with the variation function (i.e. a menu subroutine is executed when a variation point of the program is reached and, upon the selection of a user-defined function/procedure from the menu, control is passed from the menu subroutine to the selected procedure/passed into the measurement process) (column 26, lines 33-67).

Applicant then argues that, "Snyder, column 26, lines 33-67, describes how a menu may be customized by a user. However, the menu subroutine is not a process modification software module provided by the user, nor does it contain a user-defined function for causing the variation, as called for in claim 1. Further the originator of the program has predetermined which menu subroutine will be called at this point in the code. There is no need for the user to associate the menu subroutine with the call, since the association is explicit in the original code."

This argument, however, is considered moot in light of the explanation provided above. Further, it is submitted that in the invention of Snyder the measurement process is not predetermined but depends on input from the user.